

**REMARKS**

Summary of Office Action

Claims 1-12 were pending in this case.

Claims 1-12 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 1-12 were also rejected under 35 U.S.C. § 102(b) as being anticipated by Youman et al. U.S. Patent No. 5,629,733 ("Youman").

Summary of Applicants' Reply

Applicants have amended claims 1, 2, 5 and 9, and added new claims 13-20 in order to more particularly define the claimed invention. Applicants have canceled claim 4 without prejudice. No new matter has been added and these amendments and new claims are fully supported by the originally-filed application (see, e.g., applicants' specification at page 20, line 26 to page 21, line 1; page 22, line 27 to page 23, line 11; Figure 5).

The Examiner's rejections are respectfully traversed.

Applicants' Reply to the 35 U.S.C. § 112 Rejections

The Examiner rejects the previous amendments to claims 1, 2, 4, 8, 6 and 9 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Support for the claimed subject matter is provided in applicants' originally filed application as described below:

**CLAIM 1**

The Examiner asserts that there is no mention in applicants' specification of 'modification of displayed program listings to include a second program listing associated with a second television channel' (Office Action, page 4). First, the 'second television channel' is defined in claim 1 as a channel that 'provid[es] regularly scrambled television programs'. Moreover, page 2, lines 28-30 explicitly discloses the subject matter in question, stating: "The processor updates the EPG database when one of the regularly scrambled television channels in now unscrambled. The update (modification) might take the form of adding a program listing (second program listing) of the program transmitted on the now unscrambled channel (second television channel) for being displayed to the user."

The Examiner also asserts that there is no support for the modification of the displayed listings in claim 1 being performed: 'in response to determining that the second television channel received without scrambling.' However, this subject matter is also explicitly supported on page 2, lines 26-28 which state: "The processor updates the EPG database when one of the regularly scrambled television channels in now unscrambled." Thus, the EPG is being updated as a result (in response to) the television channel now being unscrambled. In addition, page 6, lines 6-9 state: "the system will only advise the user if a previously scrambled program signal is unscrambled by featuring the program prominently on the guide." Thus, because the processor modifies the EPG when the scrambled channel is unscrambled and because the system (e.g., the processor) will only feature the program if it is unscrambled,

applicants' claimed modification clearly occurs in response to determining that the program signal is received without scrambling, as recited in applicants' claim 1. Therefore, claim 1 is fully supported by the originally-filed application and does not fail to comply with the written description requirement. Accordingly, the § 112 rejection of claim 1 should be withdrawn.

#### **CLAIM 2**

The Examiner asserts that there is no support for the limitation of claim 2 which recites "turning ON the second program listing" (Office Action, page 4). Applicants have amended claim 2 to remove 'program listing' and insert 'television channel'. This amendment is support by claim 2 as originally-filed and page 2, lines 30-32 of applicants' specification. Therefore, claim 2 is fully supported by the originally-filed application and does not fail to comply with the written description requirement. Accordingly, the § 112 rejection of claim 2 should be withdrawn.

#### **CLAIMS 4 and 8**

The Examiner asserts that "[n]o where in the instant specification is it noted [the detector] is for detecting that *the second television channel is received without scrambling*" (Office Action, page 4), as specified in claims 4 and 8. However, this subjected matter is explicitly described with respect to Figure 2 on page 20, lines 27-34 which states: "FIG. 2 is a block diagram of a receiving location including a system detector 302 for receiving scrambled and unscrambled channels.

The system detector 302 determines if the channels are scrambled or unscrambled." This section of applicants' specification clearly shows and describes a detector that is part of a receiver which receives television channels and detects if the channels are unscrambled. Therefore, claims 4 and 8 are fully supported by the originally-filed application and do not fail to comply with the written description requirement. Accordingly, the § 112 rejection of claims 4 and 8 should be withdrawn.

#### **CLAIM 6**

The Examiner asserts that "receives data from a service provider indicating the periods during which one of the regularly scrambled television programs will be received without scrambling," as specified in claim 6, is not supported by applicants' specification (Office Action, page 5). The Examiner specifically points out that "there is no mention of the program being received without scrambling." However, page 2, lines 17-20 of applicants' specification clearly support this subject matter stating: "[t]he present invention is directed to ... a system with the capability for detecting whether a program signal is scrambled or unscrambled." Moreover, page 3, lines 5-7 states: "In a further aspect of the invention, a promotional message informing the user of the now unscrambled program is displayed on the guide." Therefore, claim 6 is fully supported by the originally-filed application and does not fail to comply with the written description requirement. Accordingly, the § 112 rejection of claim 6 should be withdrawn.

**CLAIM 9**

The Examiner asserts that there is no support in the instant specification for "first program listings associated with the first television channel that provides regularly unscrambled television programs," as specified in claim 9 (Office Action, page 5). Applicants have amended claim 9 to remove the language 'first' in order to clarify the claim. The subject matter of claim 9 is supported in applicants' specification, at least at page 22, line 27 to page 23, line 11. Therefore, claim 9 is fully supported by the originally-filed application and does not fail to comply with the written description requirement. Accordingly, the § 112 rejection of claim 9 should be withdrawn.

Applicants' Reply to the Prior Art Rejections

Claims 1-12 were rejected under 35 U.S.C. § 102(b) as being anticipated by Youman. Applicants respectfully traverse this rejection.

Youman generally discusses an electronic program schedule system. In some embodiments, a message is displayed by the local cable operator indicating that a premium channel will have a free preview (Youman, Fig. 28, 28A; col. 19, lines 43-64).

Applicants' claim 1 patentably improves upon Youman by using a detector coupled to a processor for monitoring a television channel and detecting that the television channel is received without scrambling. The processor receives an indication from the detector and in response modifies the displayed program listings to include a program listing

associated with a regularly scrambled television channel. To anticipate a claim, a reference must teach each and every element of the claims. Applicants submit that nowhere does Youman teach or suggest a detector coupled to a processor for monitoring a television channel and detecting that the television channel is received without scrambling, as required by applicants' claim 1.

The Examiner asserts (with respect to claim 4) that because the "Free HBO Preview Tonight" message is displayed in Figure 28A of Youman that there must be a detection mechanism coupled to the processor as recited in applicants' claims (Office Action, page 7). Applicants respectfully disagree. The messages depicted in Figures 28 and 28A of Youman are sent by the local cable company (Youman, col.19, lines 50-53). Thus, it is the local cable company that is making a determination of when a regularly scrambled channel is unscrambled. The messages sent by the local cable company simply let a user know that the cable company has decided to unscramble or determine that a channel is unscrambled. Therefore, the detection that a channel is unscrambled is made, if at all, by the user reading the message, not by a detector coupled to a processor, as required by applicants' claim 1. Moreover, the messages in Figures 28 and 28A of Youman state that the premium channels will become available in the future, thus clearly demonstrating that the channels are determined to be unscrambled well before they reach the electronic program system of Youman. Since the processor of Youman does not make a determination that a television channel is received without scrambling it also cannot modify a listing in response to that determination, as required by applicants'

claim 1. Thus, Youman does not show or suggest all the limitations of applicants' claim 1. Accordingly, claim 1 and claims 2 and 5-12, which depend, directly or indirectly therefrom are patentable.

#### New Claims

Applicants have added new claims 13-20 in order to more particularly define the claimed invention. New claim 13 includes, *inter alia*, a processor that displays program listings including a first program listing associated with a first television channel that provides regularly unscrambled television programs and modifies the displayed program listings to include a second program listing associated with a second television channel that provides regularly scrambled television programs in response to determining that the second television channel is received without scrambling.

Youman does not teach or suggest modifying a displayed program listing to include a program listing associated with a regularly scrambled television channel in response to determining that the regularly scrambled channel is received without scrambling. Though Youman mentions that stored schedule information can be updated on a periodic bases (Youman, col. 8, lines 21-22) and separately shows premium channels program listings (Youman, Figure 18 "6 HBO"), nowhere does Youman teach or suggest updating a displayed program listing in response to determining that a channel is received without scrambling. Additionally, even though "HBO" is shown to provide unscrambled program listings in Figure 18 of Youman, nowhere does Youman show or suggest that these program listings for "HBO" have been included in the display in response to determining that "HBO"

Application No. 10/823,993  
Amdt. Dated May 1, 2009  
Reply to Office Action of January 5, 2009

became unscrambled. In particular, one skilled in the art can only assume, based on the disclosure of Youman, that the listings for the HBO channel are displayed regardless of whether HBO is received with or without scrambling, which is different from displaying them "in response to determining that the second television channel is received without scrambling." Thus, Youman does not show or suggest all the limitations of applicants' new claim 13.

For at least these reasons, applicants' claim 13, and claims 14-20 which depend, directly or indirectly there from, are patentable over the prior art of record.

#### Conclusion

For the reasons stated above, applicants respectfully submit that this application is in condition for allowance. Reconsideration and prompt allowance of this application are respectfully requested.

Respectfully submitted,

/Gall C. Gotfried/  
Gall C. Gotfried  
Registration No. 58,333  
Agent for Applicants  
ROPES & GRAY LLP  
Customer No. 75563